

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BAO Q. TRAN

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Appeal 2008-1214  
Application 09/792,828  
Technology Center 2100

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Decided: September 16, 2008

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Before JAMES D. THOMAS, LANCE LEONARD BARRY,  
And HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's plural rejections of claims 1 through 20. We have jurisdiction under 35 U.S.C. § 6(b).

As best representative of the disclosed and claimed invention,  
independent claim 1 is reproduced below:

1. A document drafting system to generate a document having a  
required sequence, comprising,

one or more screens to receive application text input:

an electronic agent to review the text input, to apply one or more  
diagnostic rules to the application text input and to generate zero or more  
diagnostic messages;

a visualization system coupled to one screen to graphically display  
one or more relationships between one or more text portions in the  
document; and

a document generator to assemble the text input into the document  
according to the sequence.

The following references are relied on by the Examiner:

Newman	US 5,774,833	Jun. 30, 1998
Petruzzi	US 6,049,811	Apr. 11, 2000 (filing date November 26, 1996)
Hunter	US 6,298,327 B1	Oct. 2, 2001 (filing date Mar. 8, 1999)
Takano	US 6,434,580 B1	Aug. 13, 2002 (filing date October 23, 1998)

Claims 1 through 20 stand rejected under 35 U.S.C. § 103. In the last  
Office action mailed on May 6, 2005, the Examiner set forth four separate  
rejections of the claims on appeal. These are mentioned at the bottom of  
page 6 of the principal Brief on appeal which was filed on April 25, 2007.  
In this Office action, the Examiner relies upon Hunter in view of Newman as

to claims 1 through 6, 7 through 9, 11, 12, 16, and 20 in a first stated rejection. In a second stated rejection of claims 13 through 15, and 19, the Examiner adds Petruzzi to this initial combination of references. In a third stated rejection of claim 10, the Examiner adds Takano to the combination of Hunter and Newman. Lastly, in a fourth stated rejection of claims 17 and 18, the Examiner relies upon Petruzzi in addition to Hunter and Newman.

In the Answer, the Examiner has only set forth three stated rejections that encompass the four stated rejections of the last Office action. In effect, the Examiner has combined the fourth and second stated rejections since the same prior art is relied upon. The same claims are encompassed by the first stated rejection in the Answer as are set forth in the last Office action. The same may be said of the third stated rejection in the last Office action and the third stated rejection in the Answer. The Examiner's inclusion of dependent claim 19 within the first stated rejection in the Answer, as opposed to its inclusion in the second stated rejection in the last Office action, is considered not to be prejudicial to Appellant since Petruzzi is now not relied upon by the Examiner. In any event, no arguments are presented in the Brief and Reply Brief as to this claim.

Rather than repeat the positions of the Appellant and the Examiner, reference is made to the Brief and Reply Brief (filed on August 16, 2007) for Appellant's positions, and to the Answer for the Examiner's positions.

## OPINION

For the reasons set forth by the Examiner in the Answer, as embellished upon here, we sustain the rejections of all claims on appeal under 35 U.S.C. § 103. Appellant argues independent claims 1, 9, and 20 in the principal Brief collectively. In accordance with the positions set forth at pages 15 through 17 of the principal Brief on appeal, Appellant does not present any arguments to the rejection of claims 13 through 15, 17, and 18 in the second stated rejection, instead relying upon the arguments presented with respect to their parent independent claims to urge patentability.

As to the obviousness rejections, we note the following principles:

“To reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness.... On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”

*In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006)(quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

The Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 127 S. Ct. at 1739. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. The Court noted that “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 1742.

The Federal Circuit recently concluded that it would have been obvious to combine (1) a device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) a processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). In reaching that conclusion, the Federal Circuit recognized that “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.” *Id.* at 1161 (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

In the absence of separate arguments with respect to claims subject to the same rejection, those claims stand or fall with the claim for which an argument was made. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Dovetailing with this precedent, we note further that the test for obviousness has been further characterized as not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 414, 425 (CCPA 1981); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991).

The prior art relied on to prove obviousness must be analogous art. As explained in *Kahn*,

the ‘analogous-art’ test . . . has long been part of the primary Graham analysis articulated by the Supreme Court. *See Dann [v. Johnston]*, 425 U.S. [219,] 227-29 (1976), *Graham*, 383 U.S. at 35. The analogous-art test requires that the Board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, at 1447. References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’ - in other words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the invention.” (quoting *In re Wood*, 599 F.2d 1032 (C.C.P.A. 1979))).

*Kahn*, 441 F.3d at 986-87. *See also In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (“[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”).

The Examiner’s reasoning of combinability of the respective references for each stated rejection within 35 U.S.C. § 103 appears to comply with the requirements of the above-noted case law. To the extent the Brief appears to argue otherwise such as at pages 11 through 13, the Examiner properly responds by making of record the superseding *KSR* analysis noted earlier in this opinion. In turn, only page 6 of the Reply Brief mentions this legal precedent by merely urging that the Examiner has a distorted interpretation of the term “diagnostic” to the extent recited in the claims on appeal. With respect to this position, we strongly disagree.

With respect to what Appellant argues in the Brief and Reply Brief that Hunter does not teach, it appears to us that such teachings are better represented in Newman, and vice versa. To the extent independent claim 9 presents a feature of an IP portal coupled to user workstations, figure 1 of Hunter teaches such an operator environment based upon the network system illustrated there for Hunter’s expert authoring support system for invention disclosures. The various edit windows shown at least beginning at figure 4 of Hunter illustrates not only the display capability of the claims but the ability to provide editing and therefore diagnostic capabilities within Hunter’s teachings. Even the general discussion of prior art document editors at column 3 of Hunter provides an editing and diagnostic capability

because his teachings incorporate the capabilities of prior art systems that provide diagnostic and editing capabilities into his environment. Even the assembling capability at the end of representative independent claim 1 on appeal, for example, is taught beginning at the middle of column 4. The artisan would well appreciate that the electronic agent of the claims comprises the expert support system program 9 in figure 1 of Hunter. The discussion of a help menu at the bottom of column 5 as well as the more extensive online help system at column 29 is ruled-based, which provides a basis of presenting diagnostic-type rules and/or messages as to compliance or the absence of compliance with the respective rules.

The complementary nature of Newman to the teachings in Hunter would have been readily apparent to the artisan upon a brief review of Newman. The entire nature of the disclosure of this reference relates to syntactic and semantic analysis of patent texts and their drawings as well, such as to suggest the presentation of error messages to the user upon the encountering of an error such as those mentioned in the latter portion of the abstract of Newman. The presentation would be on the output device 203 of figure 2. Each identifiable section of the patent application is analyzed according to the broad showing in figure 1. Again, building upon the editing teachings in Hunter, the word processor program 208 in figure 2 also would have been expected by the artisan to yield error messages with respect to normal word processing errors encountered in the authoring of the text of the patent document. Of particular significance are the showings in figures 4 and 5 which relate to claims dependency tree diagrams in graphical form in figure 4 and tabular form in figure 5.

The showing in figure 6 relates to the identification and therefore correlation of figure representation elements in the various figures of a patent document to the textual discussion thereof. The general application of rules is shown in figure 7 to include a parsing function which would lead the artisan to understand this reference teaches the diagnostic capabilities of the claims on appeal. Even grammar checkers are discussed at column 1 of Newman, which suggest error messages with respect to improper grammar by the author. The middle of column 6 discusses the presentation of results of the determination of errors in the grammar analysis as well. Furthermore, as noted by the Examiner in the Answer, the discussion at column 8 beginning at line 16 relates to patent text analysis to recognize errors in the overall structure of the document and therefore present to the user diagnostic-type messages with respect to these errors. Even the determination of proper antecedent basis is discussed in the portion noted by the Examiner at column 11, beginning at line 15. This discussion is continued through column 12. A ruled-based parsing system is generally discussed again at the bottom of column 12 through the end of the patent at column 14.

Thus, the reader would appreciate, to the extent argued otherwise in the Brief and Reply Brief, that the claimed features are represented in the combined, sometimes overlapping teachings of Hunter and Newman as argued by the Examiner. To the extent argued beginning at page 14 of the principal Brief that certain features of dependent claims 3 through 6, 11, and 12, are not taught among the combined teachings of Hunter and Newman, the preceding discussion indicates that the art teaches these broadly defined

features. As to the brief arguments with respect to dependent claim 16 at the top of page 15 of the principal Brief, the noted IP specialists are presented in the alternative in claim 16. These include patent agents and attorneys as first recognized to be a part of the prior art at pages 2 through 4 of the Specification as filed. Moreover, corresponding representatives are noted in the first paragraph of the summary of the invention at the bottom of column 2 in Hunter.

The brief discussion of claim 10 with respect to Takano at page 16 of the principal Brief belies the IP portal environment already indicated to the artisan in Hunter's figure 1, notwithstanding the teachings relied upon by the Examiner in Takano.

To the extent Appellant presents arguments as to claims 13 through 15, 17, and 18 at pages 5 and 6 of the Reply Brief, these positions are misplaced since Appellant has not presented any arguments with respect to these claims in the principal Brief on appeal. Therefore, any arguments that could have been made with respect to them have been waived. The remaining positions in the Reply Brief present arguments that essentially repeat those already presented in the Brief and addressed in this opinion.

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 20 under 35 U.S.C. § 103 is sustained since Appellant has not presented persuasive arguments of patentability of the claims or otherwise shown any error in the Examiner's positions. Therefore, the decision of the Examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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